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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,892	01/21/2004	Tien-Jen Cheng	FIS920030352US1	1891
32074	7590	02/15/2006	EXAMINER	
INTERNATIONAL BUSINESS MACHINES CORPORATION DEPT. 18G BLDG. 300-482 2070 ROUTE 52 HOPEWELL JUNCTION, NY 12533			LANDAU, MATTHEW C	
			ART UNIT	PAPER NUMBER
			2815	

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/707,892

Applicant(s)

CHENG ET AL

Examiner

Matthew Landau

Art Unit

2815

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-14 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-14 and 21-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

The drawings were received on December 12, 2005. These drawings are acceptable.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the conducting layer, the copper seed layer, and the nickel layer (claim 21) must be shown or the feature(s) canceled from the claim(s). Note that the drawings do not show a conducting layer. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Art Unit: 2815

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation “wherein said diffusion layer includes an adhesion layer”, in combination with all the limitations of claim 21, is not supported by the originally filed application. The only support for limitations of claim 21, specifically the combination of a conducting layer and a copper layer, is originally filed claim 6. However, that claim did not include an adhesion layer as presently claimed in claim 22. Therefore, newly added claims 22-24 constitute new matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-5 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Homma et al. (US Pat. 6,798,050, hereinafter Homma).

Art Unit: 2815

Regarding claim 1, Figure 9E of Homma discloses a chip pad comprising: a terminal metal layer 81 disposed on a passivating layer 82, a diffusion barrier layer 84/85 on said terminal metal layer; a conducting layer 86 on said diffusion barrier; a hard test barrier 87 (Pd) on said conducting layer; and a plate passivating layer 89 on said hard test barrier layer. Note that the limitation “plated” is merely a product-by-process limitation that does not structurally distinguish the claimed invention over the prior art. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966. The term “plated” refers to the manner in which the layer was made (by a plating process). Whether or not the layer was made by a plating process in no way structurally distinguishes the final product.

Regarding claims 2-4, Figure 9E of Homma discloses said diffusion barrier layer 84/85 includes an adhesion layer 85 (Ti) on barrier metallurgy 84 (TiN) (col. 11, lines 12-15).

Regarding claims 1, 5, and 7 (as an alternate interpretation), Figure 9E of Homma discloses a chip pad comprising: a terminal metal layer 81 disposed on a passivating layer 82, a diffusion barrier layer 84 on said terminal metallurgy; a conducting layer 85 on said diffusion barrier; a hard test barrier 86 (Ni) on said conducting layer; and a plate passivating layer 87 (Au) on said hard test barrier layer (col. 11, lines 20-23).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2815

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, 7, 21, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tseng et al. (US Pat. 6,696,356, hereinafter Tseng) in view of McCormick (US Pat. 6,706,622).

Regarding claims 1, 5, 7, 21, and 25, Figure 3F of Tseng discloses a chip pad comprising: a terminal metal layer 15 disposed on a passivating layer 14, a diffusion barrier layer 18 on said terminal metal layer; a conducting layer 20 on said diffusion barrier; a hard test barrier 28/26, which includes a nickel layer 28 plated to a copper seed layer 26 on said conducting layer (col. 10, lines 24-28). Note that the limitation "plated" is merely a product-by-process limitation that does not structurally distinguish the claimed invention over the prior art. The difference between Tseng and the claimed invention is a gold plate passivating layer formed on said hard test barrier. Figure 6 of McCormick discloses a bonding pad with a gold passivating layer 30 over a nickel layer 26. In view of such teaching, it would have been obvious to the ordinary artisan at the time the invention was made to modify the invention of Tseng by including a gold layer above the hard test barrier for the purpose of inhibiting oxidation of the nickel layer (col. 3, lines 41-43 of McCormick).

Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tseng in view of McCormick as applied to claim 21 above, and in further view of Degani.

Regarding claims 22-24, Figure 3F of Tseng discloses a Ti barrier layer 18 (col. 9, lines 41-43). A further difference between Tseng and the claimed invention is said diffusion barrier layer includes an adhesion layer on barrier metallurgy. Figure 9 of Degani discloses a chip pad



Art Unit: 2815

comprising a diffusion barrier layer 21/22 that includes a CrCu adhesion layer 22 between a Ti barrier layer 21 and an overlying Cu layer 23. In view of such teaching, it would have been obvious to the ordinary artisan at the time the invention was made to further modify the invention of Tseng by including a CrCu adhesion layer between the Ti barrier layer 18 and the Cu layer 20 (Figure 3F of Tseng). The ordinary artisan would have been motivated to further modify Tseng in the manner described above for the purpose of providing a solder wettable and metallurgically sound interface between the titanium layer and the subsequently formed copper layer (col. 3, lines 46-50 of Degani).

Claims 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Degani et al. (US Pat. 6,232,212, hereinafter Degani) in view of McCormick.

Regarding claims 8 and 11-13, Figures 1 and 9 of Degani disclose an IC chip 11 with a chip pad formed thereon comprising: a terminal metal layer 13 disposed on a chip passivating layer 12 and connecting to underlying chip wiring through a via through said chip passivating layer; an adhesion/barrier layer 22/21 on said terminal metal layer; a seed layer 23 (Cu) (col. 3, line 53) on said adhesion/barrier layer; and a plate passivating layer 24 (Au) (col. 3, line 63). The difference between Degani and the claimed invention is a hard test barrier layer (made of nickel) on said diffusion barrier layer. Figure 6 of McCormick discloses a bond pad structure with a nickel layer 26 between a copper layer 20 and an overlying gold layer 30. In view of such teaching, it would have been obvious to the ordinary artisan at the time the invention was made to modify the invention of Degani by including a nickel hard test barrier layer as taught by

Art Unit: 2815

McCormick for the purpose of isolating the copper from other material which may degrade the copper, or which may be degraded by the copper (col. 2, lines 5-9 of McCormick). Furthermore, it would be obvious to modify Degani to have more than one pad as taught by McCormick (Figure 6) for the purpose of allowing separate electrical connections to different portions of the integrated circuit. Note that the limitation "plated" is merely a product-by-process limitation that does not structurally distinguish the claimed invention over the prior art.

Regarding claims 9 and 10, Degani discloses said adhesion/diffusion barrier layer includes an adhesion layer 22 (CrCu) on a barrier metallurgy 21 (Ti) (col. 3, lines 41-48).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Degani in view of McCormick as applied to claim 13 above, and further in view of Homma and Bhattacharya et al. (US PGPub 2003/0034489, hereinafter Bhatt).

Regarding claim 14, semiconductor IC chips are fabricated from a wafer of semiconductor material, and the wafer is not diced into individual chips until after the ICs have been completed. Therefore, in order to make the device of Degani, there must have been a plurality of IC chips on a wafer at an intermediate stage of processing. However, Degani does not explicitly disclose that the wafer is diced into individual IC chips after forming the claimed metal layers on the IC chip substrate. Figures 9A-9E of Homma discloses forming a plurality of metal layers on a wafer prior to dicing the wafer into individual chips (col. 11, lines 38-41). In view of such teaching, it would have been obvious to the ordinary artisan at the time the invention was made to further modify the invention of Degani by dicing the wafer after forming



Art Unit: 2815

the claimed metal layers, thereby resulting in a plurality of ICs (with the claimed structure) on a wafer. The ordinary artisan would have been motivated to further modify Degani in the manner described above for the purpose of simply the production process for mass production. A further difference between Degani and the claimed invention is the ICs are identical. Bhatt discloses forming a plurality of identical ICs on a wafer (paragraph [0030]). In view of such teaching, it would have been obvious to the ordinary artisan at the time the invention was made to further modify the invention of Degani by having a plurality of identical ICs on a wafer for the purpose of simplifying the production process for mass production of a particular IC. Note that paragraph [0003] of the instant application gives a special definition to the word “die” by stating “Each array location is known as a die and each die may harbor an IC chip”. In other words, a “die” is simply the portion of the wafer where the chip is located. Therefore, it is inherent that each of said plurality of identical ICs are located in a die on said wafer.

### *Response to Arguments*

Applicant's arguments filed December 12, 2005 have been fully considered but they are not persuasive.

Applicant argues regarding the drawing objection that “a copper layer 114 is clearly shown in Figure 1...”. While this is true, the point of the drawing objection was that all the claimed layers together are not shown....including both the conducting layer and the copper layer.

In response to Applicant's statement that “the applicants note that while claim 6 is objected to, it has not been rejected for substantive reasons”, it is noted that the previous Office

Art Unit: 2815

Action provided a 103 rejection of claim 1 and 5-7 over Tseng in view of McCormick (see bottom of page 4 and top of page 5 of the Office Action mailed on 9/8/2005). Accordingly, the previous rejection is now applied to claim 21.

Applicant further argues that “no reference of record shows a “plated” hard test barrier layer” as recited in the amended claim 1 or the test barrier layer plated to a seed layer as recited in claim 8”. As stated in the above rejection, the limitation “plated” is essentially a product-by-process limitation that does not structurally distinguish the claimed invention over the prior art. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966. The ordinary artisan would recognize that the term “plated” simply means that the layer has been formed by a plating process, and therefore refers to the manner in which the layer was made. Whether or not the layer was made by a plating process in no way structurally distinguishes the final product.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 2815

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew C. Landau whose telephone number is (571) 272-1731.

The examiner can normally be reached from 8:30 AM - 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kenneth Parker can be reached on (571) 272-2298. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and (571) 273-8300 for After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should any questions arise regarding access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KENNETH PARKER  
SUPERVISORY PATENT EXAMINER

Matthew C. Landau

February 7, 2006